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09/930,422	08/15/2001	Peter Ar-Fu Lam	DISPMT1	1550
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<div>EXAMINER BUCHANAN, CHRISTOPHER R</div>				
<div>ART UNIT 3627</div>				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/930,422

**Applicant(s)**

LAM, PETER AR-FU

**Examiner**

CHRISTOPHER R. BUCHANAN

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 37-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 19-34, 37-39, 41-48, 50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9-18, 40, 49 and 52 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Specification***

2. The amendment filed September 22, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in claim 40 in section (3) the claim recites "a data compression machine", however, the specification does not provide support for this limitation. Applicant is required to cancel the new matter in the reply to this Office Action. The examiner provides some suggestions below regarding this matter.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 6, 7, 9-18, 40, 49, and 52 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101

process must be tied to a particular machine, transform underlying subject matter (such as an article or materials) to a different state or thing, or otherwise be directed to a non-abstract idea. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. The claims are non-statutory. The examiner points out that in this context subject matter would be a physical material, such as petroleum or plant fibers, and a machine could be a computer. Numerical quantities do not constitute subject matter.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al*.

5. ***To overcome the rejection under USC 101*** the examiner suggests the following amendments to claim 40: in section (2) change the first line to read "measuring

via a computer processor in length units..." and in section (3) change the first line to read "processing via a computer processor said m values...".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 9-18, 40, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spackova et al. (US 4,539,585) in view of Behram et al. (US 5,499,293).

Regarding claim 40, Spackova discloses a method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, the method including the steps of;

(1) specifying the positions of the body to be measured (indicia (74) shown in Fig. 3 specify the position) for defining m different physical dimensional parameters of said human body (the indicia segments (72) and coded indicia (74) are used to define various physical parameters of a subject wearing a form fitting garment, col. 4 line 1+, see Fig. 3),

(2) measuring in length units (x-y-z axes are for dimensions of length, col. 3 line 55, fundamental units of measurement are mass, *length*, and time) a physical dimension of said body to produce m values for each of said m defined parameters (the orientation of each segment (72) and indicia (74) are computer identified, i.e., measured and stored, col. 4 line 7+, and used to provide a body location on which items of apparel should be worn (col. 4 line 18+), wherein orientation includes rotation and *position* (col. 3 line 54+, position is measured in length units), this constitutes measuring the body and producing values for the parameters); and

(3) processing said m values to produce a multiple digits BP code for representing said m values (computer and image processor process orientation information, col. 3 line 12-15, the form fitting garment (71) contains a plurality of coded segments (72) which are used *in toto* to form a composite image of the garment and, therefore, of the subject's body since the garment is form fitting (col. 4 line 1+), the stored data for the composite image would result in a multi-digit code that represents the particular features (m values) for that body).

The method of Spackova differs from the claimed invention in that the body profile code is not explicitly shown to be a compressed code that can be decompressed to provide the original input values and in that it does not include providing printed media for recording a representation of the compressed code.

Behram discloses a means for processing m values (see Fig. 4, words, phrases, etc., are the m values) to produce a multi-digit compressed code (see Fig. 3, patient data is compressed into code, col. 14 line 30-33, utility generates compressed output

and stores onto a card) that can be decompressed to provide the original input values (col. 13 line 37+, utility can decompress the compressed information into its original form), which also includes providing printed media for recording a representation of the compressed code (col. 14 line 30-33, utility generates compressed output and stores onto a card).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Spackova so that the body profile code is a compressed code that can be decompressed to provide the original input values and to include providing printed media for recording a representation of the compressed code, as taught by Behram, to enable more efficient transmission or storage of information (see Behram col. 14 line 30-34).

Regarding claims 6, 7, 9-18 and 49, the different data strings (n1 and n2 codes) could be used for a variety of applications (garment fitting, data manipulation, etc.). The particular application selected for the n1 and n2 data strings (e.g., size chart for fitting purposes, enhance resolution, physical dimensional parameter, non-dimensional related information related to said human-body, out of range information of a parameter, etc.) would be a matter of design choice since it has not been shown to serve any particular purpose or solve any stated problem and does not affect the nature or functioning of the invention. Regarding claim 52, the compressed code can be decompressed to provide the original input values (Behram, col. 13 line 37+, utility can decompress the compressed information into its original form).

***Allowable Subject Matter***

8. Claim 8 has allowable subject matter over the prior art of record.

***Response to Arguments***

9. Applicant's arguments with respect to claims 6, 7, 9-18, 40, 49, and 52 have been considered but are moot in view of the new ground(s) of rejection. Applicant makes various arguments with regard to the prior art references, essentially that they do not disclose the claimed features of the instant invention. Applicant's arguments with regard to the Aisaka reference are moot in view of the new ground of rejection which does not involve Aisaka. Applicant argues that the Spackova reference does not show the features of steps (1) and (2) in claim 40 under normal operation, discloses a non-functional invention, is non-analogous art, etc. However, these points are just repetition of previous arguments submitted by the applicant which have already been addressed by the examiner. The examiner refers the applicant to the rejections of June 23, 2010 and December 22, 2009 for the examiner's stand on these matters.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. R. B./  
Examiner, Art Unit 3627

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627